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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,978	09/24/2003	Thomas Haas	032301.309	9246

25461 7590 11/17/2006

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ART UNIT	**PAPER NUMBER**
1754	

DATE MAILED: 11/17/2006

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/669,978
Filing Date: September 24, 2003
Appellant(s): HAAS ET AL.

Robert G. Weilacher, Esq
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 22, 2006 appealing from the Office action mailed January 30, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is substantially correct. Claims 16-18 were objected to in the final action of January 30, 2006, and were indicated as being allowable if written in independent form. Claims 16-18 were erroneously listed with the rejected claims in the Advisory Action of April 25, 2006.

This appeal involves claims 1-15.

Claims 19-27 are allowed.

Claims 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on April 18, 2006 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The issue on appeal is whether claims 1-15 are anticipated by, or rendered obvious over, Tsao '689. Also, although appellnts' state that claims 2-15 stand or fall together and are not argued separately, appellants point out on pages 10-12 of the Brief how each of claims 2-15 differs from claim 1, implicitly arguing these claims.

(7) Claims Appendix

A substantially correct copy of appealed claims 1-15 appears on pages A-1 and A-2 of the Appendix to the appellant's brief. The minor errors are as follows: Claims 16-18 should not be included in the copy of the appealed claims, since they have been objected to and indicated as being allowable if written in independent form.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US 4,889,689	Tsao	12-26-1989

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-15 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsao '689. No distinction is seen between the composition disclosed by Tsao '689, and that recited in claims 1-15. Tsao '689 discloses at col. 2, lines 48-58 that the amine content may be as low as 0.003 wt. % (30 ppm) and at col. 3, lines 30-42 that stabilizers such as ammonium stannate may be present in amounts up to about 0.1 wt.% (1,000 ppm). The composition of Tsao '689 would inherently contain less than 50 wppm alkali metals or alkaline earth metals, since there is no indication in Tsao '689 that such metals are present. In any event it would be obvious to provide less than 50 wppm alkali metals and alkaline earth metals in the composition, since Tsao teaches at col. 3, lines 30-42 that ammonium salts, rather than sodium salts, of the various stabilizers may be employed.

(10) Response to Argument

Appellants' argument, that the examples of Tsao '689 disclose an isotonic low concentrated hydrogen peroxide solution having a sodium ion content based on the weight of hydrogen peroxide that is several orders of magnitude higher than the upper limit for the alkali metal concentration according to the claims herein, is not convincing, since the teachings of Tsao '689 are not limited to the examples. Tsao '689 discloses at col. 3, lines 51-68 that there "may" be present in the stabilized hydrogen peroxide solution one or more tonicity enhancing agents. The disclosure in Tsao' 689 that one or

more tonicity enhancing agents "may" be present would imply that Tsao '689 contemplated either the presence or absence of such agents. Moreover, tonicity enhancing agents do not appear to be present in the hydrogen peroxide solution disclosed at col. 4, lines 55-65 of Tsao '689. The fact that tonicity enhancing agents are present in the examples of Tsao '689 but do not appear to be required to be present in the general disclosure of the reference is akin to a preferred embodiment in Tsao '689 of the presence of tonicity enhancing agents. Accordingly it would be obvious to exclude the tonicity enhancing agents in the composition of Tsao '689, since Tsao '689 merely "prefers" that such agents be present (col. 3, lines 51-68). It is well-settled that non-preferred embodiments constitute teachings upon which a case of prima facie obviousness may be based.

Appellants' argument, that an informed selection from among the many possibilities described in Tsao '689 would have to be made in order to arrive at a concentration of anions of more than 100 wppm and an alkali metal concentration of less than 50 wppm, is not convincing. Tsao '689 specifically disclose at col. 3, lines 30-39 that the stabilizers may be ammonium stannates, and would not have to be alkali metal stannates. Accordingly the presence of the stabilizer in the composition of Tsao '689 would provide at least 100 wppm anions or compounds that can dissociate to form anions while still providing less than 50 wppm alkali metals. Moreover, Tsao '689 clearly discloses the presence of diethylene triamine penta(methylenephosphonic acid) (not necessarily a salt thereof) in an amount of 0.003% by weight (30 wppm) at col. 2, lines

48-58. Accordingly Tsao '689 discloses the presence of less than 50 wppm of amines, without the introduction of alkali metals.

Appellants' argument, that the fact that alkali metal ions are not present in the claims of Tsao '689 is no basis for alleging that they are , in fact, not present, since it is well-known that commercial hydrogen peroxide solutions contain high amounts of alkali metal ions and/or amines, is not convincing, since appellants have not provided any evidence which would support the conclusion that commercial hydrogen peroxide solutions contain high amounts of alkali metal ions and/or amines. The fact of the matter is that one of ordinary skill in the art would recognize from reading col. 3, lines 51-58 and col. 4, lines 55-65 of Tsao '689 that alkali metal ions would not have to be present in the hydrogen peroxide solution.

Appellants' argument, that claims 2 and 3 differ from claim 1 by specifying that the amount of components of group (i) in total is less than 40 and 35 wppm, respectively, is not convincing. Since it has been shown that Tsao '689 contemplates the absence of alkali metals, obviously Tsao '689 contemplates less than 35 wppm alkali metals.

Appellants' argument, that claims 4-6 differ from claim 1 by specifying that the amount of components of group (ii) is less than 40, 30, 20 and 10 wppm, respectively, and that claim 8 differs from claim 1 by specifying that the amines are selected from mthe group consisting og primary, secondary and tertiary alkylamines, is not convincing. As pointed out by appellants on page 8 of the Brief, Tsao '689 does not

mention amines of any kind. Accordingly Tsao '689 there would be present in the solution of Tsao '689 less than 10 wppm of amines, regardless of the type of amine.

Appellants' argument, that claim 9 differs from claim 1 by specifying that the solution further contains at least 100 wppm of bases with a pk_B of at least 4.5 or the corresponding protonated compounds in total based on the weight of hydrogen peroxide, is not convincing. Tsao '689 teaches at col. 2, lines 51 and 62 that the solution may have a pH as high as about 7.5. It would be obvious to achieve such pH with at least 100 wppm of bases with a pk_B of at least 4.5 or the corresponding protonated compounds in total based on the weight of hydrogen peroxide.

Appellants' argument, that claims 10-13 differ from claim 9 by further specifying the amount of components of group iv, is not convincing, since it would be within the skill of one of ordinary skill in the art to determine a suitable amount of the bases with a pk_B of at least 4.5 or the corresponding protonated compounds in total based on the weight of hydrogen peroxide in order to achieve a pH of about 7.5 or less.

Appellants' argument, that claims 14 and 15 specify that the base may be ammonia, is not convincing. Ammonia is a well-known base. It would be obvious to employ such a well-known base in the composition of Tsao '689 to provide a pH of about 7.5 or less.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
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Conferees:

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